## REMARKS

The above amendment and these remarks are responsive to the communication designed FINAL from Examiner S. Pannala dated 18 Mar 2004.

Claims 1-22 are in the case, none having been allowed.

### *35 U.S.C. 103*

Claims 1-2, 4-22 have been rejected under 35 U.S.C. 103(a) over McGee (US Patent 6,393,468) in view of Sutter (US Patent 6,446,092).

Claim 3 has been rejected under 35 U.S.C. 103(a) over McGee, in view Sutter and in view of Forbes et al. (U. S. Patent 6,381,742). Claim 3 depends from claim 2.

Applicants traverse, and argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references

2. that were available to the inventor and

3. that teach

4. a suggestion to combine or modify the references,

5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. [See Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 43 USPQ 2d 1294 (Fed. Cir. 1997)]. That a claimed invention may employ known principles does not itself establish that the invention would have been obvious, particularly where those principles are employed to deal with different problems. [See Lindermann, supra.] The Examiner must consider the claim as a whole, and not piece together the claimed invention using the claims as a guide. The Federal Circuit has stated: "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. [See

In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)].

"In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the Examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). (Ex parte Rao S. Chintakrindi, Thomas E. Murphy, Paul F. Rieth and Jeffrey S. Stevens, Non-binding decision of the Board of Patent Appeals and Interferences, 9/30/2003 in Appeal No. 2001-2578, Application No. 08/977,547 filed 25 Nov 1997, END919970136US1.)

"A rejection under 35 U.S.C. § 103 must be based on whether there is a teaching, motivation, or suggestion to select and combine the references based on objective evidence of record. Therefore, the Examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996). Additionally, 'the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.'" (Ex parte Rao S. Chintakrindi, Thomas E. Murphy, Paul F. Rieth and Jeffrey S. Stevens, Non-binding decision of the Board of Patent Appeals and Interferences, 9/30/2003 in Appeal No. 2001-2578, Application No. 08/977,547 filed 25 Nov 1997, END919970136US1.)

Applicants invention is about offline web applications. That is, applicants provide to client browsers multiple offline subscriptions that replicate securely, each subscription including client-side runtimes and frameworks that let a user interact with the application of the website when unplugged, that is, offline with respect to the website, in a manner that is secure and that has data-

integrity through replication and synchronization.

With McGee, an end user can only use the web experience with the browser connected to the net. Unplug the net connection, and the user is unable to function. The browser in McGee has a cache of read-only pages, none of which execute the server's database or page-transition logic. So, unplugged, the user is unable to interact with the application of the website.

Applicants define "subscription" at page 24, lines 11-17 as follows:

> "A subscription is... a secured (that is, ACL protected) database or collection of databases containing off-line web applications with synchronization schedules and with which an authorized user may interact, either on-line or with an off-line instantiation."

There is no teaching in McGee of a "subscription", as applicants have defined the term.

The Examiner relies on Sutter for a teaching of the

concept of subscription, stating:

> "Sutter teaches as Independent Distributed Database
> System (IDDS) work offline with local data and all
> application transactions are against a local database.
> Sites sharing the same data synchronize their changes
> periodically in the background and changes made at one
> site become visible to all other interested sites (at
> Fig. 1, col. 10, lines 21-33)...." [Response to
> Arguments, Office Action, page 8.]

There is, in this teaching, no suggestion of "subscription"
as that term is used in applicants' claims.

Rather, Sutter teaches that his system is peer to peer,
with each node accessing other nodes for replication at the
same privilege level. This is what Sutter teaches:

> "...all sites in the IDDB, i.e. nodes, are peers and no
> site acts as a server for another. Each site stores
> 'all and only' the data it needs. It is a feature of
> the present invention that users always work off-line
> with local data, and all application transactions are
> against a local database. Sites sharing the same data
> synchronize their changes periodically in the
> background and changes made at one site become visible
> to all the other interested sites. It is a feature of
> the IDDB database that there are no on-line or
> distributed application transactions, as all
> application transactions are local. There are network

transactions, but they operate fully in the background and are not visible to the application, i.e. the user." [Sutter, col. 10, lines 21-33.]

The Examiner also refers to Sutter at Col. 91, lines 22-43 for a teaching of "network transactions for replication and security mechanisms are provided for securing transactions." (Office Action, page 9.) Also, the Examiner references Sutter at Col 12, lines 40-64 which refer to run-time processes. Neither of these references teach applicants' "subscription".

That is, Sutter never teaches access controls on a subset of data that is going through replication on some schedule or in accordance with rules defined for the subset.

On the other hand, applicant provide, in a sense, a bounded portion of databases, with meta data attributes for how data in that portion is to be used and managed. Sutter assumes it is ok to push all data to all lap tops. Applicants teach and claim a subscription in which individual subsets of data must have rules and security policies.

While Sutter is a peer to peer system, applicants' invention is not peer to peer, but rather master-slave.

This is brought out in applicants' claims by reciting a server and a browser (that is, master and slave).

Sutter provides for a data replication and data access-control replication system only. Applicants' invention provides an application and application-environment replication system, built upon a data and data-access replication system. Again, the key distinction lies in the definition of subscription. Applicants' subscriptions, unlike Sutter on which the Examiner relies for a teaching of subscription, are logical groupings of data PLUS (a) application implementations (such as forms, views, agents, code routines) AND (b) application-instance security context (such as roles like manager/non-manager that the application logic responds to differently). Nothing in Sutter provides for delivering application implementation and security context along with the data. Applicants have again amended all independent claims in the case to even more clearly state this distinction.

The combination of Sutter and McGee does not account for ways to setup, configure, and manage a web server. If applicants were to take all the web server implementation files, store them as data in IDDB, then IDDB could be used

to replicate those files everywhere. But then what? Something still needs to treat those files as executables, unpack them, configure them, run them, administer them, and shut them down. Updates to subparts of the web server container and the web applications need to be replicated, added successfully to the existing configuration, version managed and administered. This is what applicants invention provides: an integrated means for transporting, unpacking, configuring, updating, administering a container and applications contained [See pages 22 and 23 of the specification.]

Applicants urge that claims 1-2 and 4-22 be allowed.

The McGee reference is about how a web server enforces logins and then uses those logins for optimizing its caching. The Sutter reference is about peer to peer replication of data. The Forbes references is about incremental installers of application logic using XML. None, separately or in combination, and that even with the hindsight reconstruction of these references based upon the teachings of applicants' own claims, teach applicants invention. That invention is based upon subscriptions containing subsets of data providing client-side runtime and

framework for a fully functioning offline server for offline operation of a client browser.

With respect to Forbes, Forbes teaches at Col. 12:29-14:3 a manifest for incremental installation of application logic onto a machine using XML and namespaces. There is no teaching of a "subscription" as that term has been defined by applicants in the amended parent claim and discussed previously with respect to McGee and Sutter.

The only way that Sutter, McKee and Forbes can be combined in a way to teach applicants' invention is through impermissible hindsight reconstruction of the fair teachings of the references using applicants own clams as the road map.

Applicants urge that claim 3 also be allowed.

## SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-22.

The Application is believed to be in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Sincerely,

C. J. Kraenzel, et al.

By

Shelley M Beckstrand
Reg. No. 24,886

Date: 17 June 2004

Shelley M Beckstrand, P.C.
Attorney at Law
314 Main Street
Owego, NY 13827

Phone:      (607) 687-9913
Cell:       (607) 427-0802